PATENT

Attorney Docket No.: **08350.1575-00000**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	)	
	)	
DAVID J. DODDEK et al.	)	Group Art Unit: 2863
	)	
Application No.: 10/025,717	)	Examiner: Aditya S. Bhat
	)	
Filed: December 19, 2001	)	
	)	
For: SYSTEM AND METHOD FOR ANALYZING AND REPORTING MACHINE OPERATING PARAMETERS	)	Confirmation No.: 8006

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Pursuant to 37 C.F.R. § 41.41, Appellant submits this Reply Brief in response to the Examiner's Answer ("Answer") mailed June 11, 2008.

Response to New Arguments Set Forth in the Examiner's Answer

In the Examiner's Answer, the Examiner proffers new arguments not previously made in this case. Appellant respectfully submits the following remarks in response to these new arguments.

The § 103(a) Rejection of Independent Claim 1 Should Be Reversed

In the Answer, the Examiner has misconstrued claim 1 in a manner not previously documented. The Examiner now alleges that claim 1 is much broader than it actually is. Specifically, the Examiner alleges that , "the portion of the claim that recites 'based on the results' . . . does not require the results of a first diagnostic process be incorporated into the next diagnostic process to be run." Answer at 10. The Examiner concludes that the "recitation of '[conditioning] at least one diagnostic process to execute automatically based on the results of at least one other diagnostic process' only requires that the initial diagnostics be complete before continuing onto [sic] the next diagnostic process." Answer at 10-11. In support of this conclusion, the Examiner cites paragraph [28] in the present specification, which indicates that "[f]or example, if the owner defined a test for oil pressure with a set of associated parameters, the owner may wish to define a second, unrelated, test for engine speed[.]" Emphasis as supplied by Examiner.

Appellant agrees with the Examiner's allegation that the recitation of "based on the results" in claim 1 does not necessarily require the results of a first diagnostic process to be incorporated into the next diagnostic process to be run. However, the Examiner's conclusion that the "based on the results . . ." clause of claim 1 "only

requires that the initial diagnostics be complete before continuing onto [sic] the next diagnostic process[,]" is not supported by the specification, as alleged by the Examiner.

The discussion in paragraph [28], which was cited by the Examiner, does not correspond to the "based on the results . . ." clause of claim 1. Rather, it is the disclosure in paragraph [29] (not paragraph [28]) that describes the features in the "based on the results . . ." clause of claim 1. In particular, paragraph [29] specifies that a testing "procedure is defined, preferably by the owner via the interface 116" and that "a procedure may consist of . . . conducting two (or more) tests . . . and [in some embodiments] conditioning a second test on the results of the first test." Paragraph [29] also provides an example of such a conditional execution of subsequent tests, describing a test on engine boost pressure. Paragraph [29] explains that "if an exception is generated by this test, i.e. if the boost pressure is too high and operating outside of the defined limits, a second test or round of tests, such as oil pressure and/or engine speed, may be conducted to test the conditions which may be contributing to the boost pressure exception."

To summarize the teachings of paragraph [29] quoted above, an owner may define a testing procedure, which may consist of conducting two or more tests. In some embodiments, a second test may be executed if a prior test within the same testing procedure produces a certain result. Note that in the example given in paragraph [29], both boost pressure and engine speed are part of the same testing procedure. Similarly, independent claim 1 specifies that defining a testing procedure is accomplished by "selecting from a plurality of pre-defined owner inputs each associated with one or more diagnostic processes," which establishes multiple diagnostic

processes from which a user may choose. Claim 1 further recites that "defining the testing procedure includes conditioning at least one diagnostic process to execute automatically based on the results of at least one other diagnostic process." Therefore, in light of the specification, it is clear that, in claim 1, the "at least one other diagnostic process" upon which the execution of the at least one diagnostic process is conditioned is one of the diagnostic processes associated with the plurality of pre-defined owner inputs. That is, in claim 1, the first diagnostic process and the second diagnostic process are part of the same testing procedure.

Appellant would like to clarify one nuance of this feature of claim 1. The Examiner appears to have interpreted the "based on the results . . ." language in claim 1 to impose a condition upon the wrong verb in the claim. The full clause at issue reads as follows:

> wherein defining the testing procedure includes conditioning at least one diagnostic process to execute automatically based on the results of at least one other diagnostic process.

Emphasis added. It appears that the Examiner has mis-interpreted the clause to require "conditioning . . . based on the results . . . ." Answer at 22, para. 16a. However, as illustrated in the block quote above, it is the double-underlined language that is tied together (i.e., ". . . execute . . . based on the results . . ."). That is, in claim 1, it is the verb "execute" and not the verb "conditioning" that is "based on the results . . . ." As discussed above, paragraph [29] in the specification provides an example wherein defining the testing procedure may involve conditioning a second test or round of tests to execute if a machine exception is detected during a first test. Thus, when read in light of paragraph [29] in the specification, it is clear that in claim 1 it is the execution of

the at least one diagnostic process (and not the conditioning of the execution of at least one diagnostic process) that is "based on the results of at least one other diagnostic process."

Further, in view of the foregoing discussion, it would not make sense to interpret claim 1 to encompass executing the second process based on a manufacturer's previous experience (as opposed to executing the second process based on results of a diagnostic process within the same testing procedure). Claim 1 explicitly recites defining a testing procedure by "conditioning at least one diagnostic process to execute automatically based on the results of at least one other diagnostic process." Therefore, at the time the testing procedure is defined, (i.e., when the conditioning takes place), the "other diagnostic process" must not have been performed yet. If the first diagnostic process *had* already been performed prior to defining the testing procedure (e.g., as a manufacturer's previous experience would be), the execution of the at least one diagnostic process could not be conditioned upon the results of the other diagnostic process. That is, if the execution of a second process is dependent (i.e., conditional) upon the results of a first process, then the first process must be something that would take place in the future. Otherwise, if at the time the testing procedure is defined, the first process has already been completed, then there is no reason for "conditioning" a second process upon the results of the first process because the results of the first process are already known. In such case, the second process could simply be defined to execute based on the results of the first process, instead of conditioned to execute based on the results.

Therefore, the specification does not to support the Examiner's conclusion that the "based on the results . . ." clause of claim 1 "only requires that the initial diagnostics be complete before continuing onto [sic] the next diagnostic process[.]" Rather, the specification (e.g., para. [29]) clarifies that the "at least one other diagnostic process" upon which the execution of the at least one diagnostic process is conditioned is one of the diagnostic processes associated with the plurality of pre-defined owner inputs, and that it is the verb "execute" and not the verb "conditioning" that is "based on the results . . . " in claim 1. Further, it would not make sense to interpret claim 1 to encompass executing the second process based on a manufacturer's previous experience. Appellant respectfully submits that, for at least the foregoing reasons, the Examiner has misconstrued independent claim 1, particularly the "based on the results . . . " clause. Appellant respectfully submits that a proper construction of Appellant's claim 1 does not read on the combined disclosures of Pillar and Rother, or even on the *alleged* disclosure of Pillar and Rother as interpreted by the Examiner.

Furthermore, Appellant submits that, even if the Examiner's construction of claim 1 were proper, the Examiner's construction of claim 1 would not define subject matter that would have been obvious over the combined disclosures of Pillar and Rother. The Examiner has taken the position that the recitation of "the results of at least one other diagnostic process" in claim 1 reads on Rother's disclosure of "manufacturer's . . . previous . . . diagnosis experience" mentioned in Rother. Answer at 16-17. This, however, is not an accurate interpretation of Rother. Rother does not disclose or suggest that the series of tests execute (or are even conditioned to execute) based on the manufacturer's previous diagnosis experience. Instead, Rother discloses listing (not

executing) tests in a particular order based on the manufacturer's previous diagnosis experience.

Rother discloses that "a list of tests to be performed . . . [is] listed in the order in which they would most likely be effective in diagnosing the vehicle faults, based upon the manufacturer's information . . . ." Col. 3, lines 26-33. Although not definitive, this passage, without further context, could arguably be interpreted to mean that the tests are listed in an order in which their combined execution would most likely be effective in diagnosing the vehicle faults. However, Rother clarifies, at column 4, lines 44-53, that "[t]he test procedures are listed in the order of the probability or likelihood that the test will be successful in diagnosing the cause of the selected symptom or symptoms . . . ." Therefore, in Rother, the tests are not executed, or even conditioned to execute, based on the manufacturer's previous diagnosis experience. Rather, the manufacturer's previous diagnosis experience is merely used to determine the likelihood of success of each individual listed test for purposes of creating a list of tests from which to choose, wherein the tests are listed in order according to likelihood of success. Appellant respectfully submits that listing tests in an order according to each test's likelihood of success does not constitute "conditioning at least one diagnostic process to execute automatically based on the results of at least one other diagnostic process," as recited in claim 1. Thus, Rother does not cure the acknowledged deficiencies of Pillar with respect to claim 1.

In view of the foregoing, Appellant respectfully submits that the Examiner has not established that all the recited features of independent claim 1 are either explicitly or implicitly disclosed in the applied references or are otherwise suggested to one of

ordinary skill in the art. For at least these reasons, the Examiner has not established a *prima facie* case of obviousness with respect to independent claim 1. Accordingly, Appellant respectfully submits that the § 103(a) rejection of independent claim 1, should be reversed.

The § 103(a) Rejection of Independent Claim 8 Should Be Reversed

The discussion above regarding the Examiner's new arguments with respect to independent claim 1 is also applicable to independent claim 8, which requires an "analyzer . . . configurable to execute at least one diagnostic process automatically based on the results of at least one other diagnostic process." Thus, Appellant respectfully submits that, for substantially the same reasons discussed above with respect to independent claim 1, none of Pillar, Rother, or any other source discloses or suggests this feature, and that, accordingly, the § 103(a) rejection of independent claim 8 should be reversed.

The § 103(a) Rejection of Independent Claims 14 and 17 Should Be Reversed

With regard to independent claims 14 and 17, in the Answer, the Examiner has presented new arguments in support of the Examiner's allegation that the recitation of "at least two limits" in claims 14 and 17 read on the upper and lower values of the measurement ranges provided in the chart spanning columns 8-10 of Pillar. Specifically, the Examiner now cites a dictionary, which defines the term "limit" as "something that bounds, restrains, or confines," and defines the term "range" as "a sequence, series, or scale between limits." Answer at 11. Based on these definitions, the Examiner concludes that the recitation of "at least two limits" in claims 14 and 17

read on the upper and lower values of the measurement ranges provided in the chart spanning columns 8-10 of Pillar.

Appellant respectfully disagrees. The Examiner is basing this argument on a general definition of the term "limit" as being something that bounds something else, such as a range. However, the claim language is more specific. For example, claim 14 requires:

> defining at least one testing procedure by selecting from a plurality of owner inputs, each associated with one or more diagnostic processes . . . wherein said defining step includes the steps of . . . defining at least two limits for the at least one parameter, wherein machine data that exceeds at least one of the limits is considered a machine exception[.]

Emphasis added. Thus, in claim 14, there are at least two limitations on the "at least two limits" that are not disclosed or suggested by Pillar. First, as recited above, the process of defining at least one testing procedure includes defining at least two limits by selecting from a plurality of owner inputs. Pillar does not disclose or suggest any method involving an owner defining limits. Second, Pillar does not specify that exceeding the so-called "limits" that bound the ranges listed in the chart spanning columns 8-10 is considered a machine exception. Instead, in Pillar, the chart heading merely lists these ranges as "Exemplary Measurement Range(s)," and the disclosure of Pillar does not provide any further description of these exemplary ranges or the upper and lower bounds thereof. For at least these reasons, Pillar fails to disclose or suggest "defining at least two limits for the at least one parameter, wherein machine data that exceeds at least one of the limits is considered a machine exception[,]" as recited in independent claim 14.

Appellant respectfully submits that, for substantially the same reasons discussed above regarding the Examiner's new arguments with respect to the claimed "at least two limits" in claim 14, Pillar also fails to disclose or suggest all the recited features of independent claim 17. For example, Pillar fails to disclose or suggest a system for analyzing machine data, including, among other things, "an owner input device . . . configured to accept owner input to: . . . define at least two limits for the at least one parameter, wherein machine data that exceeds at least one of the limits is considered a machine exception[,]" as recited in claim 17. Emphasis added.

Rother is cited only for an alleged teaching of conditioning at least one diagnostic process to execute automatically based on the results of at least one other diagnostic process. Thus, Rother does not cure the above noted deficiencies of Pillar with respect to claims 14 and 17. Because neither Pillar nor Rother, or any legally proper combination thereof, discloses or suggests all of the features recited in claims 14 and 17, no *prima facie* case of obviousness has been established with respect to claims 14 and 17. Accordingly, Appellant respectfully submits that the § 103(a) rejection of claims 14 and 17 should be reversed.

Conclusion

For the reasons presented in the Appeal Brief filed November 13, 2007, and the additional reasons outlined above, all of the outstanding claim rejections should be reversed, so that pending claims 1-14 and 16-19 may be allowed.

If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.

Dated: August 8, 2008

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